

REMARKS

Claims 1-39 are pending in the present application. Claim 1 has been amended.

The undersigned contacted SPRE Meredith Petrovic on or about July 12, 2007 to discuss an Office Action in this case dated April 17, 2007. The discussion did not focus on the merits of the patentability of the pending claims, but whether the new Office Action after a Decision on Appeal was appropriate. In response to that call, the present Office Action was mailed replacing the previous one. A separate call to Ms. Petrovic was made by the undersigned on or about January 31, 2008. The same issues were discussed, and the undersigned was informed that the latest Office Action is proper from a procedural standpoint. Based on the discussion below, Applicants maintain that prosecution of this case should not have been re-opened based on the content of the new Office Action.

In the Final Office Action of January 22, 2004, claim 32 was rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,855,007 to Jovicic ("Jovicic"). The Board Decision states that "In Jovicic, there is no disclosure of the user being enabled to select a reward for redemption from the list of rewards previously collected by the user, because in Jovicic, the redemption performs this function, and there is no evidence in the record to suggest the obviousness of this limitation." Board Decision, September 25, 2006, p. 17 (emphasis in original). The emphasized language was incorporated into the claims.

Claims 1-16 were rejected under 35 U.S.C. § 112, second paragraph as failing to distinctly claim the present invention. The claims have been amended as requested by the Examiner. Accordingly, reconsideration and withdrawal of the rejection is respectfully

requested.

Claims 1, 5-13, 16-22, 24-25 and 38 were rejected under 35 U.S.C. § 102(e) as being anticipated by Jovicic or in the alternative under 35 U.S.C. § 103(a) as being unpatentable over Jovicic. Claims 2-4, 14-15, 23, 26-31 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jovicic. Claims 32-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jovicic in view of U.S. Patent No. 6,237,145 to Narasimhan et al. (“Narasimhan”).

Each of the pending independent claims refers to the user being able to select a reward for redemption from the list of rewards previously collected by the user (see claim 32). Claim 1 refers to viewing “a list of rewards that have been allocated to the user and enabling the user to select a reward for redemption from the list of rewards.” Claim 17 recites, “when the user wishes to redeem a reward, the central computer allowing the user to view a list of rewards associated with the user as stored in the database; allowing the user to select a reward from the list of rewards for redemption by interacting with the database.” Claims 19, 20 and 38 include similar limitations.

The current Office Action re-opens prosecution by stating that “the subject limitation for all of the independent claims except claim 32 is in fact taught by the reference (as the *browsing memory 128*, at col. 6 lines 11-13, which was not previously cited by the examiner).” (emphasis in original). First, the Board’s Decision was quite clear that Jovicic does not disclose the feature in the claims. Col. 6, lines 11-13 of Jovicic, read as follows “... a browsing memory 128 where representative coupon or coupons are stored and ready for selection by users.” There is nothing in this cited section or anywhere in Jovicic that states that coupons in the browsing memory are

those “previously collected” by the user. The language of the cited section is that the coupons are “representative” and thus available to all users accessing the Internet Coupon Server 124 (see, e.g., Col. 6, lines 39-48). Nonetheless, though the Examiner interprets Col. 6, lines 11-13 as a different citation from Jovicic not previously cited by the Examiner, the citation was clearly in front of the Board (see Board Decision, September 25, 2006, p. 9). Accordingly, in view of this section, the Board decision is that the feature of claim 32 is not taught nor suggested by Jovicic including what is referred to as the new citation of Col. 6, lines 11-13.

As to claim 32, the Office Action states that Col. 8, lines 19-21 of Jovicic teach this feature. This text states as follows, “An added feature of the invention is that the user may choose to e-mail the coupon to him or herself allowing him or her to store the coupon for a later date handling or send it directly to the vendor’s Internet node over public computer network.” Again, Col. 8, lines 19-21 of Jovicic is not a new citation, as with Col. 6, lines 11-13, Col. 8, lines 19-21 were specifically addressed by the Board at page 9 of its decision. Col. 6, lines 29-36 of Narashimhan add nothing to this section of Jovicic.

In view of the Board’s Decision and its specific dealing with the Jovicic reference, including the citations used in the present Office Action, it would seem that the issue of whether the feature of claim 32 that has been added to each of the independent claims as been resolved in Applicant’s favor. Accordingly, reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. §§ 102(e) and/or 103(a) is respectfully requested.

CONCLUSION

The Applicants respectfully submit that the present case is in condition for allowance and respectfully requests that the Examiner issue a notice of allowance.

The Office is hereby authorized to charge any fees determined to be necessary under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayment to Kenyon & Kenyon **Deposit Account No. 11-0600**.

The Examiner is invited to contact the undersigned at (202) 220-4255 to discuss any matter concerning this application.

Respectfully submitted,

Dated: February 25, 2008



Shawn W. O'Dowd
(Reg. No. 34,687)

KENYON & KENYON LLP
1500 K Street, N.W.
Suite 700
Washington, D.C. 20005
Tel: (202) 220-4200
Fax: (202) 220-4201
DC01 707699